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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/143,343	08/28/1998	MARK A. BOYS	P644	3403

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EXAMINER

TRAN, THAI Q

ART UNIT PAPER NUMBER

2615

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/143,343

Applicant(s)

BOYS, MARK A.

Examiner

Thai Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed June 7, 2002 have been fully considered but they are not persuasive.

In re pages 5-6, applicant argues that there is nothing whatsoever in the referenced portion of Yuen having anything to do with initiating a perpetual recording of presented media, as is claimed in step (a) of applicant's clam 18, applicant fail to see how the descriptions in col. 26, lines 60-67 and col. 33, line 54 to col. 34, line 67 of Yuen read on applicant's claimed step (b), and that in the portions cited Yuen discloses processes for indexing or re-indexing a tape, searching the tape for a selected program or identifying a recorded program, but nowhere deals with settings and initiating selected playback or permanent storage of media wherein activating a flag-set indicia from a user interface on the perpetual recording device enables playback or storing of the flagged media.

In response, the examiner respectfully disagrees. Yuen discloses in col. 12, lines 52-67 that the VCR 10 is used to record the television programs from broadcast or cable by either read time recording, timer programming his VCR, or using a "VCR PLUS+tm" programming system. It is noted that perpetual can be defined as "continuing without interruption or surcease". The capability of recording the television program using VCR 10 of Yuen by either read time recording, timer programming his VCR, or using a "VCR PLUS+tm" programming system will not be interrupted or surceased.

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Thus, Yuen does indeed disclose the claimed step (a) initiating perpetual recording of the presented media.

The advancing the tape to the beginning of each program during the re-indexing process disclosed in col. 26, lines 60-67 of Yuen or monitoring the VM packet in indexing the video tape disclosed from col. 33, line 54 to col. 34, line 67 of Yuen anticipates the claimed step (b) identifying a specific media selection during media presentations because the user identifies a specific media selection during media presentations.

Regarding steps (c)-(e) of claim 18, the cited portions of Yuen teaches the claimed setting and initiating selected playback or permanent storage of media wherein activating a flag-set indicia from a user interface on the perpetual recording device enables playback or storing of the flagged media because Yuen can mark the begin and end of television segments and play back the marked television segments by using the marks.

In re page 6, applicant argues that the marks described in Yuen are therefore beginning marks for program portions, not a flag-set marking the beginning and end of a desired block of media, as claimed.

In response, the examiner respectfully disagrees. Yuen discloses in col. 17, lines 48-55 that "when program five is recorded, the indexing VCR 10 writes a **VISS mark at the beginning of program five** and writes a TP packet (shown as TP(5) corresponding to program five in line 19 of the VBI. Upon reaching the start of program three, the indexing VCR 10 erases the VISS mark corresponding to the start of program three and

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writes **a new mark at the end of program five** which becomes the start of the remaining portion of program three". From above passage, it is clear that Yuen does disclose the claimed wherein in step (c) the flag-set marks the beginning and end of the desired block of media because the system of Yuen marks the beginning and end of program five.

In re pages 6-7, applicant argues that applicant again points out to the Examiner that Yuen does not disclose a perpetual recording device, as recited in the preamble of claim 1, at all.

In response, as discussed above with respect to claim 18, Yuen does indeed disclose the claimed perpetual recording device as required by claim 1.

In re page 7, applicant states that claim 19 is dependent upon applicant's method claim 18 and, in view of applicant's above arguments on behalf of method claim 18, applicant believes claim 19 is therefore patentable on his own merits, or at least as dependent from a patentable claim.

In response, as discussed above with respect to claim 18, Yuen discloses all the features of claim 18.

In re page 7, applicant states that, with respect to claim 21, in view of applicant's above arguments pertaining to claim 18, applicant believes that it has been clearly demonstrated that the reference of Yuen does not support a prima facie rejection, and is therefore not a proper primary reference for combining with Ichinose to read on applicant's claimed invention.

In response, as discussed above with respect to claim 18, Yuen discloses all the features of claim 18. Thus, Yuen can be used as primary reference for combining with Ichinose.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 18, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuen et al ('409) as set forth in paragraph #3 of the last Office Action.

Regarding claim 18, Yuen et al discloses the method for setting and initiating selective playback or permanent storage of stored audio or audio-visual media from a user-interface on a perpetual recording device coupled with a media presentation device (Fig. 1 and its respective disclosure) comprising steps of:

(a) initiating perpetual recording of the presented media (recording the video programs received from an antenna 63 or a cable TV signal source 64 of Fig. 1, col. 12, lines 52-67);

(b) identifying a specific media selection during media presentations (advancing the tape to the beginning of each program during the re-indexing process disclosed in col. 26, lines 60-67 or monitoring the VM packet in indexing the video tape disclosed from col. 33, line 54 to col. 34, line 67);

(c) activating a flag-set indicia from a user interface on the perpetual recording

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device (re-indexing process disclosed in col. 26, lines 60-67 or indexing the video tape disclosed from col. 33, line 54 to col. 34, line 67);

(d) activating a recover indicia from the user interface of step (c), the recover operation for retrieving the flagged media (Searching Tape for Selected Program disclosed from col. 28, line 20 to col. 29, line 7 or Identifying A Recorded Program disclosed from col. 46 line 64 to col. 47, line 2); and

(e) initiating playback or media store of the flagged media (Searching Tape for Selected Program disclosed from col. 28, line 20 to col. 29, line 7 or Identifying A Recorded Program disclosed from col. 46 line 64 to col. 47, line 2).

Regarding claim 20, Yuen et al discloses the claimed wherein in step (c) the flag-set marks the beginning and end of the desired block of media (the start and end of the program or segment of the program disclosed in col. 17, lines 51-55 and col. 9, lines 48-67).

Regarding claim 22, Yuen et al also discloses the claimed wherein in step (d) the indicia is a memory button that searches for the set flags automatically (the program number disclosed in the Searching Tape for Selected Program in col. 28, lines 22-67 or the program number disclosed in the Identifying A Recorded Program from col. 46, line 64 to col. 47, line 2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen et al ('409) as set forth in paragraph #5 of the last Office Action.

Regarding claim 1, Yuen et al discloses all the features of the instant invention as discussed above in claim 1 except for providing a speaker system.

The capability of using speaker system in the television receiver for audibly outputting the audio signal reproducing from the video cassette recorder is old and well known in the art and therefore Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known speaker system into Yuen et al's system in order to audibly listen to the audio signal reproducing from the VCR.

Regarding claim 2, Yuen et al discloses the claimed wherein the perpetual recording device of claim 1 coupled with one of an RF radio or a television (the antenna 63 or the cable TV signal source 64 of Fig. 1, col. 12, lines 52-67 or the video display 50 of Fig. 1, col. 11, lines 3-12).

Regarding claim 3, the combination of Yuen et al and the Official Notice as set forth in claim 1 above discloses all the features of the instant invention except for providing an analog to digital converter and wherein the at least one data store is a write able digital memory accepting data writes comprising digitally recorded media.

The capability of digitally recording broadcasted video signal using analog to digital converter and digital recording medium such as digital VCR is old and well known in the art and therefore Official Notice is again taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known digital VCR into Yuen et al's system in order to increase the quality of the video signal to be reproduced from the digital recording medium because digital recorder has higher quality than analog recorder.

Regarding claim 4, the claimed wherein the flag-set denotes one of a complete song, or a block of completed songs is met by col. 26, line 60-67 and from col. 33, line 54 to col. 34, line 67.

Regarding claim 17, the claimed wherein coupling results in internalizing the device into the circuitry of the media presentation device is met by the VCR-1, the antenna 63, and the cable TV signal source 64 of Fig. 1, col. 5, lines 23-39 and col. 7, lines 39-45).

Claim 19 is rejected for the same reasons as discussed in claim 3 above.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen et al ('409) in view of Ichinose ('569) as set forth in paragraph #6 of the last Office Action.

Yuen et al discloses all the features of the instant invention as discussed in claim 18 above, however, Yuen et al does not specifically disclose wherein in step (d) the indicia is a jogging wheel manually operated to search the flag-sets.

Ichinose teaches a video editing viewer having a jogging wheel (6 of Fig. 1, col. 2, lines 14-39) for selecting an editing point.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the rotary knob 6 of Ichinose into Yuen et al's system in order to facilitate the processing of searching the beginning of each program.

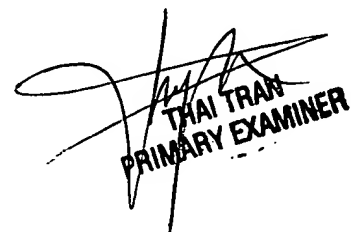
7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


THAI TRAN
PRIMARY EXAMINER